

Remarks and Arguments

Applicants have carefully considered the Office Action dated April 21, 2004 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Applicants and their attorney wish to thank Examiner Jean for the courtesy of the office interview at the USPTO on June 29, 2004 , in which the currently cited references and the amendments to the claims, as set forth herein, were discussed.

Claims 13-19, 25, and 27-54 are currently pending in the subject application.

Claims 25, 29 and 53 have been amended to correct grammatical errors. These amendments have not been made to distinguish over any reference of record and no narrowing of any corresponding equivalents to which the amended limitation(s) or claim(s) are entitled is intended by these amendments.

Claims 13-19, 25, and 27-54 stand rejected under 35 USC Section 102 (b) as being anticipated by any of U.S. Patent No. 5,513,117, hereafter Small, and European Patent application EPO 784 394 A1, Chaturvedi et al., hereafter referred to as Chaturvedi. In addition, claims 13-19, 25, and 27-54 further stand rejected under 35 USC Section 102 (e) as being anticipated by U.S. Patent No. 6,453,300, Simpson.

Before addressing the Examiner's rejections, Applicants request that Examiner consider the following. The present invention discloses a method, system, computer program product, data structure for enabling users to select over a computer network any of a plurality of gifts from a vendor web site and to designate a recipient. The user can then access, from the same site or a different site, a compilation of customizable cards. The user can then independently select any of the cards and personalize the selected card through various modifications. The selected, personalized card is printed at the location where the gift that has been ordered on line is physically located. The personalized card and corresponding gift are matched and combined as a single parcel for shipment to the designated recipient. In the present invention, the gifts are not just gift certificates, but physical entities of different types. Further, the card and gift combination is not predetermined, i.e. the selected gift does not predefine or limit the selection of cards, nor does the selected card predefine or limit the selection of gift(s).

Accordingly, the present invention allows any number of independently selectable, cards to be customizable and matched with any number of selectable gifts, without predetermined limitations, and for the customized card and gift(s) to be sent together as a single combined entity to the designated recipient.

In contrast, the Small, Chaturvedi, and Simpson references, on which the current set of rejections are based, do not provide a personalizable card that can be selected independent of any of a plurality of items ordered on line. Chaturvedi discloses a kiosk based systems, with a limited number of physical gifts. Small discloses a kiosk based systems, with only gift certificate-type or electronically vendable gifts. Simpson discloses a system in which the recipient criteria dictate the card and the variation of the gift type. None of the references on which the current rejections are based disclose the ability to select from a plurality of customizable cards and any of a plurality of on-line accessible gifts, from a variety of vendors, and to have the customized card and gift matched and physically shipped as a single entity to a designated recipient. Additional comments distinguishing the cited references over the claim subject matter are set forth below by reference.

Simpson describes a system for providing a "gift card" and for personalizing the gift card (Simpson, col. 3, lines 19-24). In Simpson, the card device 10 includes a compact disc 62 or other storage medium, a gemstone or birthstone 70 and a sheet of the printable material 76 and 78 insertable into the compact disc case 54 (Simpson, col. 3, line 30 through col. 4, line 15). Essentially, all of these elements comprise the card. In fact, Simpson expressly admits that if the custom "gifting" is desired to be shipped with the gift card, only coupons or vouchers referring to the gift can be utilized, as evidenced by the following passage:

Another customizable feature that can be used in accordance with the present invention, is that when the purchaser is customizing the CD on-line, he/she may add custom "gifting" to be included with the card to be presented to the recipient. This feature is driven by a "Giftbox" selection process available on the website. The gifting process enables the purchaser to select at least some of a plurality of available gifts, such as

free or discounted items, that the purchaser believes the recipient may enjoy receiving. *The actual physical gifts selected are not included with the CD. Instead, coupons or vouchers for the gifts, which can later be used by the recipient to obtain the actual gift, are provided on the CD and can, for example, be printed therefrom when the recipient is viewing the CD presentation.* The gifts may be any suitable type of gift that can be initially presented to the recipient, such free or discounted goods or services like communication services (cell phones, wireless and long distance telephone service), Internet access, software, flowers, movie videos or tickets, clothing and fashion products, cologne/perfumes, dining and small vacation packages, or the like. The content of the CD may provide an infomercial-type presentation relating to the selected gifts, and then provide the user with information on how to obtain the gift, such as by printing a coupon good for movie tickets and/or other gift items. The CD may also provide hotlink functionality to enable the user to access websites associated with the available gifts to, for example, learn more information about the gift or related products and services.

(Simpson, Col.7, line 7-36, *emphasis added*)

Even if the Examiner considered either the birthstones or the CD as gifts and not parts of the card, in Simpson, the purchaser does not have a choice of stone or the information accessed on the CD. Instead, the recipient information, e.g. the birth date and month, is used as the selection criteria. Simpson specifically states:

In a more specific embodiment, the card is a birthday card and the gift is a birthstone. A set of twelve such cards can be made each being tailored to one of the twelve months of the year and containing a specific birthstone for each month, respectively. Each card can be color coordinated to the color of the birthstone and may include a detailed photograph or drawing of the birthstone on the front cover 12a thereof. Information and decorative indicia may also be printed in any suitable

location on the card. For example, the card could include a picture of a birthflower corresponding to the birthstone, information on an interesting event occurring in that month or an interesting person born in that month, and/or information on the stone itself, including famous examples of the stone, hardness, care and cleaning instructions, or any other desired information.

(Simpson, Col. 4, line 22-26)

Preferably, the program uses the data entered by the purchaser of the card to select the type of information which will be displayed to the recipient on the computer. For example, if the card is a birthday card and the purchaser has entered the birth date of the recipient, the program on the CD uses that birth date information to determine what information available on the CD to display to that particular recipient. For example, if the recipient is born in September, the program preferably selects information relating to that month.

(Simpson, Col. 6, line 3-11)

The Examiner has not shown where in Simpson a purchaser can choose any card with any birthstone, or , vice versa, or any card with any subset of information on the CD or , vice versa. In fact, in Simpson, the purchaser may select the category of cards such as, birthday, Valentine, etc., but the card is selected from the data entered about the intended gift recipient (Simpson, col. 9, lines 5-10; col. 12, lines 17-34). Accordingly, Simpson does not provide for a personalizable card that can be selected independent of the item ordered on line, as now claimed.

Further, in Simpson, the customer does not enjoy a full selection of different gift types, but is limited to those few items in inventory, i.e. birthstones or gemstones, or other item that is of a size and shape which is insertable into the spline portion 12 of the CD case 54 (Simpson, col. 4, lines 44-52).

Chaturvedi discloses a "greeting" booth system in which users interact with the system through a keyboard 110, CRT 120, touch screen 130, drawing pad 140,

scanner 150, camera 160, and microphone and speaker 170 to create either electronic or tangible greeting devices. The user, however, is not provided with a facility to access on line, select and customize such greeting devices. Note that the network host 200 is for forwarding an electronic greeting to the electronic mail address of a recipient (Chaturvedi, col. 4, lines 1-7) or instructions to another similar remote assembly mechanism 240 (Chaturvedi, col. 4, lines 52-58). Examiner has not shown, however, where Chaturvedi, discloses a network accessible collection of cards or gifts, as currently recited in claims 18, 19, 25, 29, 31, 35, 36, and 49. In Chaturvedi, once a card has been selected, the customer does not enjoy a full selection of different gift types that are orderable on line, but is limited to those few items in inventory within the kiosk-based system. Accordingly, Chaturvedi does not provide for a personalizable card that can be selected independent of an item ordered on line, and shipped to the same recipient. Accordingly, applicants respectfully asserts that none of the currently pending independent claims are anticipated by Chaturvedi.

In addition, although Chaturvedi mentions delivery of a personalized card in conjunction with a flower arrangement, it does not disclose, teach, or suggest how the flower arrangement and personalized card are matched and shipped as a single entity to the recipient. Accordingly, the Examiner is not entitled to rely on such a high-level disclosure as being anticipatory, without greater implementation detail.

Still further, like Simpson, the Examiner has not shown where Chaturvedi discloses a system in which tangible products are delivered simultaneously with either an electronic greeting or a tangible greeting. Chaturvedi specifically indicates that a physical version of a tangible product must be delivered separate from the electronic greeting representing the tangible product (Chaturvedi, col. 3, lines 50-57).

Small discloses a kiosk-like, automated vending apparatus for simultaneously dispensing personalized greeting cards and *electronically* vendable gifts (Small, column 2, lines 30-33). Such gifts are limited to gifts that can be evidenced by an electronically generated personalized printout combined with or printed directly on a personalized card (Small, column 2, lines 55-59). Small does not disclose a system which is capable of simultaneously delivering a personalized greeting card with a tangible gift, since there is no technique disclosed for matching and bundling of the personalized card and

the tangible gift. Like Simpson and Chaturvedi, Small does not provide the ability to order on line any of the plurality of items, but instead is limited to only *electronically* vendable gifts. Accordingly, Small does not provide for a personalizable card that can be selected independent of the item ordered on line, as now claimed.

Applicants have amended the independent claims. Claim 13 has been amended and now recites a data structure for coordinating the combined matching of a card and an item ordered on line from a vendor web site as comprising “data associating the card with the item ordered on line from a vendor web site, the identified card selected independent of the item ordered on line” (claim 13, lines 6-8). The Examiner has not shown where any of Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination disclose Applicants’ system, as now claimed. Accordingly, claim 13 is believed allowable. Claims 14-17 include all of the limitations of claim 13 and are believed allowable for at least the same reasons as claimed 13, as well as for the merits of their own respective limitations.

Claim 18 has also been amended and now recites a method comprising “authorizing matching and shipment of the card with the item that has been ordered on line as a combined package, the identified card selected independent of the item ordered on line” (claim 18, lines 11-13). The Examiner has not shown where any of Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination, disclose Applicants’ system, as now claimed, in which the card is selected independent of the item ordered on line. In the present invention, the gift selection does not limit the selection of available personalizable cards, and, the card selection does not limit the selection of gift items available on line from vendor(s). Claims 37-38 include all of the limitations of claim 18 and are believed allowable for at least the same reasons as claimed 18, as well as for the merits of their own respective limitations.

Apparatus claim 19 has been amended similar to claim 18. Specifically, claim 19 now recites a method comprising “program logic configured to receive data associating the card with an item that has been ordered on line from a vendor web site, the identified card selected independent of the item ordered on line” (claim 19, lines 9-11).

Again, the Examiner has not shown where any of Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination, disclose such an apparatus. Accordingly, claim 19 is believed allowable over the art of record for at least the same reasons as claims 13 and 18, as well as for the merits of its own respective limitations. Claims 39-43 include all of the limitations of claim 19 and are believed allowable for at least the same reasons as claimed 19, as well as for the merits of their own respective limitations.

Previously added claim 49 is the computer program product counterpart to apparatus claim 19 and has been amended similar to claim 19. Specifically, claim 49 now recites a method including “program code for receiving data associating the card with an item that has been ordered on line from a vendor web site, the identified card selected independent of the item ordered on line” (claim 49, lines 8-10). Accordingly, claim 49 is likewise believed allowable for the same reasons as claim 19, as well as for the merits of its own respective limitations. Claims 50-54 include all the limitations of claim 49, and are likewise believed allowable for the same reasons as claim 49, as well as for the merits of their own respective limitations.

Method claim 25 has been amended to include language similar to amended claim 18. Specifically, claim 25 recites a method including “printing the card in combination with the modifications at a remote location where an item, that has been ordered on line from a vendor web site, physically resides, the identified card selected independent of the item ordered on line” (claim 25, lines 6-9). Again, the Examiner has not shown where any of Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination disclose such a method. Accordingly, claim 25 is likewise believed allowable over the art of record. Claims 27-28 and 44-45 include all of the limitations of claim 25 and are believed allowable for at least the same reasons as claimed 25, as well as for the merits of their own respective limitations.

Applicants respectfully traverse the rejection of previously added claim 29 as anticipated by any of Small, Chaturvedi, and Simpson for the following reasons. Specifically, claim 29 recites a method including “accessing a card web site from a link associated with the vendor web site” (claim 29, line 6). None of Small, Chaturvedi, and

Simpson disclose accessing a card web site from a link associated with the vendor web site, as recited in claim 29, as filed. Chaturvedi also does not disclose an "on line" system as required by limitations (A), (B) and (D) of claim 29. The kiosk in Chaturvedi must be accessed in person, and cannot be accessed online. In addition, Small and Simpson do not appear to access a card web site from a link associated with the vendor web site, as recited in claim 29.

Notwithstanding the above, claim 29 has also been amended similar to claims 13,18,19, 25 and 49. Specifically, claim 29 recites a method comprising "authorizing shipment of the printed greeting card, selected from the card web site, with the item ordered online, from the vendor web site, as a combined package to the identified recipient, the identified greeting card selected independent of the item ordered on line"(claim 29, line 12-15).

Previously added method claims 31, 35 and 36 have also been amended similar to claims 13,18,19, 25, 29 and 49. Claims 31, 35 and 36 now recite methods comprising "receiving data identifying one of the plurality of greeting cards, the identified greeting card selected independent of the item ordered on line " (claim 31, lines 7-8; claim 35, lines 9-10; claim 36, lines 9-10). Accordingly, claims 31, 35 and 36 are believed allowable over the art of record for at least the same reasons as claims 13,18,19, 25 and 49, as well as for the merits of its own respective limitations. Claims 32-34 include all of the limitations of claim 31 and are believed allowable for at least the same reasons as claimed 31, as well as for the merits of their own respective limitations.

Further, in setting forth the rejection, the Examiner has cited specific sections of Small, Chaturvedi, and Simpson which are alleged to disclose the limitation of all the claims. After review of the cited portions of Small, Chaturvedi, and Simpson, Applicants respectfully traverse the rejection as improper. Specifically, to anticipate a claim, a reference must teach every element of the claim (MPEP Section 2131). As to claims 37, 39-40, and 50-51, the Examiner has failed to indicate where any of Small, Chaturvedi, and Simpson disclose the limitation of "program logic configured to present an image of the card in combination with the received modifications to the card in WYSIWYG format" (claim 40, lines 2-3; see also claim 30, lines 2-3; claim 37, line 2;

and claim 51, lines 2-3). The Examiner will note that the Figure 6 of Simpson is not WYSIWYG presentation of the image of the card in combination with the received modifications. The legends associated with the card graphics and figure six of Simpson says quote the card which accompanies the Greetings CD you are about to create will look a lot like this on the inside" (Simpson, Figure 6). A WYSIWYG presentation of an image is an exact image of what will be printed. Simpson's explicit indication in using the term "a lot" provides evidence that the illustrated graphic is only an approximation and not an exact WYSIWYG image. In addition, the Examiner has failed to indicate where any of Small, Chaturvedi, and Simpson disclose the limitation of "program logic configured to present an image of the card in combination with the received modifications to the card" (claim 39, lines 2-3; see also claim 50, line 2). A presentation of just the text portion of a card is not an image of the entire card, as in the present invention. Such limitations are disclosed in great detail in the subject specification (page 19, line 14 through page 20, line 19; see also Figs. 6A-D). Accordingly, Applicants respectfully submit that claims 30, 37, 39-40, and 50-51, in their current form, are not anticipated by any of Small, Chaturvedi, and Simpson, and, therefore, allowable over the art of record, whether considered singularly or in combinations.

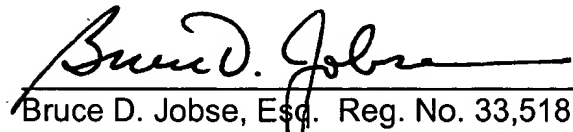
Applicants further respectfully assert that an attempt to combine any of Small, Chaturvedi, and Simpson would not set forth a *prima facie* case of obviousness as there is a disclosure, suggestion or motivation in any of Small, Chaturvedi, and Simpson that their respective disclosures be somehow combined.

Applicants respectfully reassert all of the remarks and traversals set forth in prior responses to the extent still relevant to the outstanding rejections.

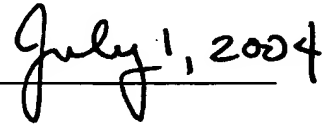
The amendments to the claims as set forth herein have been offered to advance this application to issue. None of the amendments made herein should be construed as an admission that the subject matter of the claims, as originally filed, is anticipated by or made obvious in light of any art of record whether considered singularly or in combinations. Applicant expressly reserves the right to pursue the originally filed claims in another co-pending application without being prejudiced by any amendments, including cancellation of claims, made herein.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,



Date: _____



Bruce D. Jobse, Esq. Reg. No. 33,518
KUDIRKA & JOBSE, LLP
Customer Number 021127
Tel: (617) 367-4600 Fax: (617) 367-4656